## Remarks

Claims 2 and 7 to 18 were pending and before the Examiner. By this Amendment, claim 2 has been amended. As no new matter has been added thereby, entry of the amendment is respectfully requested. Claims 2 and 7 to 18, as amended, are now pending and before the Examiner. The previous Amendment is also requested to be entered if it has not been and is reflected in the instant claims, as amended. Applicants point out that similar issues (e.g., concerning the enablement of "prevention" in the claims) are present and similar rejections have been made in copending U.S.S.N. 10/757,015, which is also being examined by the Examiner.

The Examiner again rejected claims 2 and 7 to 18 as allegedly unpatentable under 35 U.S.C. § 103(a) over De Gasparo *et al.*, in light of Robl *et al.*, in view of Cecil's Textbook of Medicine (2000), Harlan *et al.* (U.S. Patent Appl. Pub. No. 2001/0006656), and Bohm *et al.* (WO 02/15891).

Applicants again respectfully traverse the rejection. A *prima facie* case of obviousness generally requires the satisfaction of three criteria: (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings; (ii) there must be a reasonable expectation of success; and (iii) the references when combined must teach or suggest all of the claim limitations. *See* M.P.E.P. § 2143. De Gasparo *et al.* does not specifically disclose the specific combination of telmisartan and atorvastatin anywhere. The teachings and statements in De Gasparo *et al.* must be considered in context and interpreted as a whole. De Gasparo *et al.* does not give any preference to any particular combination within the broad disclosure, certainly not a specific combination of telmisartan and atorvastatin. Indeed, De Gasparo *et al.*, at page 3, line 22, merely defines "$AT_1$ receptor antagonists" as including a number of commercially available sartans including telmisartan, which is not disclosed as a selected compound in the context of a specific combination, much less with atorvastatin. The only sartan specifically mentioned in De Gasparo *et al.* in the context of a specific combination is valsartan which actually teaches away from telmisartan as a preferred combination partner. Similarly, in De Gasparo *et al.*, atorvastatin is mentioned on page 5, lines 6 and 10, but not in the context of a specific combination, much less with telmisartan. On page 5, line 26, De Gasparo *et al.* teaches that atorvastatin is a preferred

composition partner with valsartan (not telmisartan) again teaching away from telmisartan as a preferred combination partner of atorvastatin. Instead De Gasparo *et al.* on page 6, line 8 refer to a combination of statins such as atorvastatin with ACE inhibitors while there is no analogous teaching with regard to $AT_1$ receptor antagonists at all. Furthermore, none of Robl *et al.*, Cecil's Textbook of Medicine, Harlan *et al.*, or Bohm *et al.* provide what De Gasparo *et al.* lacks in providing to one of skill in the art as a motivation, reasonable expectation of success, or teaching or suggestion of all of the claim limitations of the claimed invention.

First, Robl *et al.* does not teach structures which encompass atorvastatin, does not teach combinations of atorvastatin with any compound except for the class of HMG-CoA reductase inhibitors claimed, and does not even mention telmisartan. Second, the teaching of Harlan *et al.* is confined to aerosol formulations of statins: such formulations are not intended to combine a statin such as atorvastatin with an antihypertensive, much less with telmisartan. Third, the teaching of Bohm *et al.* is confined to a combination of telmisartan with the ACE inhibitor ramipril, i.e., to two active ingredients acting on the renin-angiotensin system but not on HMG-CoA reductase. Fourth, Cecil's Textbook of Medicine neither mentions telmisartan nor atorvastatin. Finally, neither De Gasparo *et al.*, Robl *et al.*, Cecil's Textbook of Medicine, Harlan *et al.*, nor Bohm *et al.* teach or suggest that telmisartan increases the expression of genes regulated by the PPARgamma receptor, i.e., an activity known from antidiabetic drugs, which is the reason that telmisartan is a preferred combination partner for atorvastatin in the treatment of, e.g., diabetes, and this metabolic activity appears to be unique for telmisartan and is not recognized in the prior art. Indeed, De Gasparo *et al.* teaches the use of $AT_1$ receptor antagonists of "differing structural features" and therefore suggests that the specific chemical structure is of no concern and none of the other art cited makes up for this defect. Furthermore, neither Harlan *et al.* (disclosing an aerosol formulation of statins) nor Bohm *et al.* (disclosing a combination of telmisartan with ACE inhibitors) disclose, suggest, or hint at telmisartan combinations with statins and it is unclear why or how one of skill in the art at the time the claimed invention was made would combine their teachings with De Gasparo *et al.* Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants submit that all the pending claims are allowable and respectfully solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview

would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Respectfully submitted,

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